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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/04/2008

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EXAMINER

NGUYEN, VAN H

ART UNIT

PAPER NUMBER

2194

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/574,697	Applicant(s) CHAU ET AL.	
	Examiner VAN H. NGUYEN	Art Unit 2194	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-9, 41, 43-54, 68, 69, 78 and 79 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-9, 41, 43-54, 68, 69, 78, and 79 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is responsive to the Amendment filed 04/18/2008.

Claims 2-9, 41, 43-54, 68, 69, 78, and 79 are currently pending in this application.

Independent claims 43 and 69 have been amended.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-9, 41, 43-54, 68, 69, 78, and 79 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 43: the term “*a host device*” (line 15) renders the claims indefinite. It is not clear if it is referring to “*a host device*” recited at line 12.

Dependent claims 2-9, 41, 44-54, 68, 78, and 79 are rejected for fully incorporating the deficiencies of their base claim.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2-9, 41, 43-54, 68, 69, 78, and 79 are rejected under 35 U.S.C. 102(b) as being anticipated by **Carlisle et al.** (US 5649118 A).

As to claim 69:

Carlisle teaches a portable integrated circuit card interface device, comprising:
an application memory; an application engine for managing one or more applications in said application memory; an input/output module; a host interface; one or more integrated circuit card interfaces; means for operation without external power (see the *portable smart card* discussion; col.17, line 20-col.18, line 56);

means for a standalone mode of operation in which the interface device is not operably connected to a host device via the host interface (*a portable smart card 410 which contains a memory capable of storing and updating information for a user... The smart card 410 runs an executable operating system that is accessed via a set of operating system commands. These commands manipulate a file system on the card in accordance*

with rules required by card security) [see col.17, line 20-col.18, line 13]; and

means for a reprogramming mode of operation for adding, modifying, or deleting programs from the interface device (*By employing EEPROM 4115 in the smart card 410, an authorized user has the ability to reprogram certain application files in the memory section of the card while at an authorized associated application station with new and different data as desired... Data may be written to and read or erased from an EEPROM*) [see col.17, line 20-col.18, line 13].

As to claim 2:

Carlisle teaches said application memory further comprises a read-only memory [see Fig.10 and the discussion beginning at col.17, line 20].

As to claim 3:

Carlisle teaches said application memory further comprises an electrically erasable programmable read-only memory [see Fig.10 and the discussion beginning at col.17, line 20].

As to claim 4:

Carlisle teaches said application engine further comprises a microcontroller [see Fig.10 and the discussion beginning at col.17, line 20].

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As to claim 5:

Carlisle teaches said microcontroller further comprises said application memory [see Fig.10 and the discussion beginning at col.17, line 20].

As to claim 6:

Carlisle teaches said input/output module comprises a microcontroller[see Fig.10 and the discussion beginning at col.17, line 20].

As to claim 7:

Carlisle teaches said application engine further comprises a custom circuit [see Fig.10 and the discussion beginning at col.17, line 20].

As to claim 8:

Carlisle teaches said custom circuit further comprises said application memory [see Fig.10 and the discussion beginning at col.17, line 20].

As to claim 9:

Carlisle teaches said input/output module further comprises a custom circuit [see Fig.10 and the discussion beginning at col.17, line 20].

As to claim 41:

Carlisle teaches the interface device is portable [see Fig.10 and the discussion beginning at col.17, line 20].

As to claim 43:

Carlisle teaches an integrated circuit card interface device (see the *portable smart card* discussion; col.17, line 20-col.18, line 56) comprising: an application memory; an application engine for managing one or more applications in said application memory; an input/output module; a host interface; one or more integrated circuit card interfaces; and an internal power supply (see the *portable smart card* discussion; col.17, line 20-col.18, line 56);

wherein the interface device is adapted to enable operation in accordance with multiple modes of operation comprising

a standalone mode of operation in which the interface device is not operably connected to a host device via the host interface [see col.17, line 20-col.18, line 13], and

a reprogramming mode of operation, in which the interface device is operably connected to an integrated circuit via one of the one or more integrated circuit card interfaces, and/or to a host device via the host interface, to enable one or more programs to be added

to, modified in, or deleted from, the interface device [see col.17, line 20-col.18, line 13].

As to claim 44:

Carlisle teaches the standalone mode of operation comprises a mode of operation in which the interface device is operably connected to an integrated circuit card via one of the one or more integrated circuit card interfaces to enable communication between the interface device and the integrated circuit card [see Fig.10 and the discussion beginning at col.17, line 20].

As to claim 45:

Carlisle teaches the standalone mode of operation further comprises a mode of operation in which the interface device is not operably connected to another device to enable communication therebetween [see Fig.10 and the discussion beginning at col.17, line 20].

As to claim 46:

Carlisle teaches the multiple modes of operation further comprise a connected mode of operation in which the interface device is operably connected to a host device via the host interface to enable communication between the interface device and the host device [see Fig.10 and the discussion beginning at col.17, line 20].

As to claim 47:

Carlisle teaches during the connected mode of operation the interface device is also operably connected to an integrated circuit card via one of the one or more integrated circuit card interfaces to enable communication between the interface device and the integrated circuit card [see Fig.10 and the discussion beginning at col.17, line 20].

As to claim 48:

Carlisle teaches the multiple modes of operation further comprise a mode of operation in which the interface device is operably connected to a host device via the host interface to enable communication between the interface device and the host device [see Fig.10 and the discussion beginning at col.17, line 20].

As to claim 49:

Carlisle teaches during the connected mode of operation the interface device is also operably connected to an integrated circuit card via one of the one or more integrated circuit card interfaces to enable communication between the interface device and the integrated circuit card [see Fig.10 and the discussion beginning at col.17, line 20].

As to claim 50:

Carlisle teaches the standalone mode of operation comprises a mode of operation in which the interface device is not operably connected to another device to enable

communication therebetween [see Fig.10 and the discussion beginning at col.17, line 20].

As to claim 51:

Carlisle teaches the multiple modes of operation further comprise a connected mode of operation in which the interface device is operably connected to a host device via the host interface to enable communication between the interface device and the host device [see Fig.10 and the discussion beginning at col.17, line 20].

As to claim 52:

Carlisle teaches during the connected mode of operation the interface device is also operably connected to an integrated circuit card via one of the one or more integrated circuit card interfaces to enable communication between the interface device and the integrated circuit card [see Fig.10 and the discussion beginning at col.17, line 20].

As to claim 53:

Carlisle teaches the multiple modes of operation further comprise a connected mode of operation in which the interface device is operable connected to a host device via the host interface to enable communication between the interface device and the host device [see Fig.10 and the discussion beginning at col.17, line 20].

As to claim 54:

Carlisle teaches during the connected mode of operation the interface device is also operably connected to an integrated circuit card via one of the one or more integrated circuit card interfaces to enable communication between the interface device and the integrated circuit card [see Fig.10 and the discussion beginning at col.17, line 20].

As to claim 68:

Carlisle teaches a display unit; and an input unit [see Fig.10 and the discussion beginning at col.17, line 20].

As to claim 78:

Carlisle teaches the one or more programs are subject to security verification [see Fig.10 and the discussion beginning at col.17, line 20].

As to claim 79:

Carlisle teaches the interface device is operable while being carried by a user [see Fig.10 and the discussion beginning at col.17, line 20].

Response to Arguments

4. Applicant's arguments with respect to claims 2-9, 41, 43-54, 68, 69, 78, and 79 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5. The prior art made of record, listed on PTO 892 provided to Applicant is considered to have relevancy to the claimed invention. Applicant should review each identified reference carefully before responding to this office action to properly advance the case in light of the prior art.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information

6. Any inquiry or a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: (571) 272-2100.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VAN H. NGUYEN whose telephone number is (571) 272-3765. The examiner can normally be reached on Monday-Thursday from 8:30AM 6:00PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MENG-AI AN can be reached at (571) 272-3756.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/VAN H NGUYEN/
Primary Examiner, Art Unit 2194**